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Dated: November 16, 2009
Electronic Signature for James E. Armstrong, IV: /James E. Armstrong, IV/

Docket No.: 80357(47762)
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Masanobu Fukuda et al.

Application No.: 10/583,714

Confirmation No.: 6623

Filed: June 20, 2006

Art Unit: 1794

For: INK AND LAMINATED SHEET

Examiner: S. I. Reddy

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

In response to the restriction requirement set forth in the Office Action mailed October 14, 2009, with November 14 and 15 being a Saturday and Sunday, applicant hereby provisionally elects claims 1-4, 11 and 12 for continued examination, **with traverse**.

The Examiner has required restriction between:

Group I, claim(s) 1-4, 11 and 12 drawn to an ink; and

Group II, claim(s) 5-10, 13 and 14 drawn to a laminated sheet.

In accordance with PCT Rule 13.1, claims lack unity of invention if they are not so linked to form a single general inventive concept. Pursuant to PCT Rule 13.2, this can be shown if the claims lack the same or corresponding special technical feature(s).

The subject matter of these groups represent different embodiments of a single inventive concept for which a single patent should issue. More particularly, a single, searchable, unifying aspect links all of the claims. This single, searchable, unifying aspect comprises the metal thin film fragments of the claimed size in a composition with no water. In other words, this is the corresponding special technical feature which is nowhere disclosed in Sawa et al.

Claim 1 discloses an ink, which comprises metal thin film fragments and a binder resin having at least one selected from the group consisting of a carboxyl group, a phosphoric acid group, a sulfonic acid group, metal salts thereof and an amino group. Claim 5 discloses a laminated sheet which comprises multilaminated synthetic resin films and a decorative layer formed at the laminate interface of the synthetic resin films, and the decorative layer is made of an ink disclosed in Claim 1.

USP 6,616,741 discloses a water metallic ink used for a pen, and therefore a considerably large amount of water is included in the ink. On the other hand, the claimed invention provides an ink and a laminated sheet, wherein ***no water is used substantially for an ink***, as disclosed in Claims 11 an 13.

In this way, Groups I and II have one or more special technical features which define a contribution which each of the claimed invention, considered as a whole, makes over prior art (USP 6,616,741, Sawa et al.).

Further, Applicants submit that a sufficient search and examination with respect to the subject matter of all claims can be made without serious burden. As M.P.E.P. § 803 states:

If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.

That is, even if the above-enumerated groups of claims are drawn to distinct inventions, the Examiner must still examine the entire application on the merits because doing so will not result in a serious burden. This is especially true given that, by searching for the metal thin film fragments of the claimed size in a composition without water, the Examiner will necessarily have searched all the various aspects recited in the pending claims.

Accordingly, in the interest of cost and time savings to both Applicants and the United States Patent and Trademark Office, Applicants respectfully request that the restriction requirement be reconsidered and the elected claims of Group I be rejoined with those of Group II, so that all pending claims may be presently examined.

Claim objections

As for the alleged lack of clarity of the claims, the recitation, "the metal thin film fragments having an average thickness of 0.01 to 0.1 μm " is clear as will be shown below.

Metal thin film fragments of the claimed invention are thin particles, and are obtained from a metal thin film having an average thickness of 0.01 to 0.1 μm such as a metal vapor-deposited thin film (please refer to the recitation on page 6, lines 18 to 22 of the present specification). For example, as shown in Examples of the present specification, the metal thin film can be changed to fine fragments by stirring in a solvent, and obtained fine fragments were filtrated and dried.

Since a metal thin film having an average thickness of 0.01 to 0.1 μm is used, metal thin film fragments included in an ink of the claimed invention are thin and have an average thickness of 0.01 to 0.1 μm .

In the field of fine particles or fine grains, when the size of fine particles or grains are determined, a Coulter Counter, wherein electric resistance method using the Coulter Principle is applied, is generally used. The Coulter Counter is a well known apparatus for counting and sizing fine particles. Of course, it is possible to evaluate flat particles with a Coulter Counter.

A Coulter Counter is usually used to determine the size of particles in the field of powders. As can be shown by a brief internet search, the Coulter Counter is well documented and a Coulter Counter is one of the apparatuses which can determine the size of fine particles, and can be applied to determine the size of particles having a diameter of 0.3×10^{-6} in or more.

Since the values of the average thickness and the average particle diameter of particles are disclosed and there is a recitation that particles can be generated from a metal thin film in the present specification, a person with ordinary skill in the art can understand that metal thin film fragments disclosed in Claim 1 of the present invention are thin particles having an average thickness of 0.01 to 0.1 μm .

Based on the forgoing showing, it is respectfully requested that the restriction requirement be withdrawn, and that each of claims 1-14 presently pending in this application be examined.

Dated: November 16, 2009

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Respectfully submitted,

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